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| 10/501,048 | 07/09/2004 | Hirotake Nozaki | 120335 | 1655 |
| 25944 7590 02/25/2011 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER | | | | |
| BEMBEN, RICHARD M | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
jarnstrong@oliff.com

Office Action Summary

Application No.

10/501,048

Applicant(s)

NOZAKI ET AL.

Examiner

RICHARD BEMBEN

Art Unit

2622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 14, 15, 30, 46, 48, 49, 54-56 and 58-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 14, 30, 54-56 and 58 is/are allowed.
- 6) ☒ Claim(s) 46, 48, 49 and 59-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 46, 48, 49 and 59-61 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

2. The information disclosure statement filed June 30, 2010 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, cite no. 4. It has been placed in the application file, but the information referred to therein has not been considered.
3. The information disclosure statement filed July 15, 2010 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,786,417 issued to Kondo et al. ("Kondo") in view of U.S. Patent Number 6,445,460 issued to Pavley ("Pavley").

Regarding **claim 46**, Kondo discloses an image storage apparatus (c.4, II.35-53; c.12, II.6-54; Fig.35, host computer 201) comprising:

a connecting device (c.12, II.2-24; c.12, II. 34-44; Fig.35, serial interface 215) that connects to a storage medium recording image data (c.12, II.6-11; c.12, I.55-c.14, I.17; Fig.35, memory card 202; Fig.36);

a delete instruction device that instructs so as to delete image data recorded in the storage medium connected to the connecting device (c.15, I.31-c.16, I.44; Fig.38);

a medium detector that detects if the storage medium connected to the connecting device is a storage medium limiting a number of overwrite (c.15, I.31-c.16, I.44; Fig.38);

an image storage memory (c.12, II.6-54; Fig.35, e.g. hard disc 211, RAM 212);
and

a delete control device that controls so as to receive image data recorded in the storage medium connected to the connecting device, store the received image data in the image storage memory (c.12, II.45-54; Fig. 35, CPU 217) and determines to perform automatic deletion of image data of the storage medium based on whether or not the storage medium connected to the connecting device is a storage medium limiting the number of overwrite (c.15, I.31-c.16, I.44; Fig.38), wherein:

when the medium detector detects that the storage medium limiting a number of overwrite is connected to the connecting device, the delete control device halts the performing of the automatic deletion of image data (c.15, l.31-c.16, l.44; Fig.38).

However, Kondo does not disclose that the delete control device 1) determines to perform automatic deletion of the image data of the storage medium *after storage thereof* and 2) halts the performing of the automatic deletion of the image data *after storage thereof*.

Pavley discloses an image storage apparatus comprising a delete control device 1) determines to perform automatic deletion of image data on a storage medium *after storage thereof* and 2) halts the performing of the automatic deletion of the image data *after storage thereof* based on whether or not the image data is protected (c.5, l.46-c.6, l.24). It would have been obvious to one of ordinary skill in the art at the time of the invention to automatically delete image data on a storage medium after subsequent storage of the image data and halting the automatic deletion after subsequent storage if the image data is protected as disclosed by Pavley in the system disclosed by Kondo. One of ordinary skill would have been motivated to automatically delete image from a storage medium (such as a memory card) has been backed up (on a host computer, for example) and is not protected from deletion in order to free up memory space on the storage medium. Prudent use of memory is a major consideration in consumer electronics.

Regarding **claim 48**, refer to the rejection of claim 46 and Pavely further discloses that when the medium detector detects that the storage medium limiting a number of overwrite is connected to the connecting device, the delete control device inquires whether the image data is deleted (c.5, I.61-c.6, I.24, e.g. detecting whether storage space can reclaimed and whether/what images can be deleted).

Claim 49 is directed to a computer readable medium encoded with a control program corresponding to the functionality of the apparatus required by claim 46. Therefore, claim 49 is analyzed and rejected as discussed with respect to claim 46. Also refer to Pavely, c.6, I.25-63 and Fig.7.

Regarding **claims 59, 60 and 61**, refer to the rejections of claims 46, 48 and 49, respectively.

Allowable Subject Matter

6. Claims 11, 14, 15, 30, 54-56 and 58 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 11 and 54, Examiner could not find prior art disclosing the claim limitation: "when the medium detector detects that the storage medium limiting a number of overwrite is inserted into the insertion portion, the display change processing

device changes a display of the display device so as not to display the delete disable release instruction".

Regarding claims 15 and 55, Examiner could not find prior art disclosing the claim limitation: "when the medium detector detects that the storage medium limiting a number of overwrite is inserted into the insertion port and also deletion of the image is instructed by the delete instruction device, the delete method change processing device creates new data management information showing a state in which image data corresponding to image data for which deletion of the storage medium limiting a number of overwrite is instructed and management information which does not allow writing in an area that has been once recorded, and records the data management information and the management information in the storage medium limiting a number of overwrite, and invalidates data management information that existed prior to the deletion instruction".

Regarding claims 30 and 58, Examiner could not find prior art disclosing the claim limitation: "when the capacity detector detects that the storage medium limiting a number of overwrite has memory residual capacity not enough to record new data management information in the storage medium limiting a number of overwrite, the delete instruction device instructs so as to nullify the image data area".

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RICHARD BEMBEN whose telephone number is (571)272-7634. The examiner can normally be reached on 9AM-5PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID L. OMETZ can be reached on (571)272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMB
February 16, 2011

/David L. Ometz/
Supervisory Patent Examiner, Art
Unit 2622